

REMARKS/ARGUMENTS

Applicant has amended claim 2 to recite a fibrous base material. Applicant also has amended claims 1 and 10 to recite that the amount of resin in the fibrous base material. These amendments are not the addition of new matter. Applicants original claims disclose a fibrous base material of fibers, filler and resin.

Applicant's original claim 1 recite a fibrous base material of 75 to 85 percent fibers; 5 to 25 percent filler; and resin. Original claim 10 recites a fibrous base material of 75 to 85 percent fibers; 10 to 35 percent filler; and resin. The original claims are part of the instant specification. The original claims disclose an amount of resin in the fibrous base material of 20% or less.

As a result, claim 1 has a resin content of no more than 20 percent and claim 10 has a resin content of no more than 15 percent. These amendments are not the addition of new matter. Accordingly, Applicant respectfully asks the Examiner to enter the amendments.

Under 35 U.S.C. §112 the test for determining compliance with the disclosure requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the invention as of the filing date of the application. As a bare minimum, all that is needed is that the term be implicitly disclosed.

Applicant's clearly satisfy the requirement for the recited amount of resin

using any of one of three separate tests for determining compliance. Those tests are as follows.

The original disclosure provides in haec verba support to satisfy the description requirement.

The original disclosure reasonably conveys to the artisan that the invention had possession of subject matter as of the filing date of the application.

The Board of Patent Appeals and Interferences in EX PARTE THOMAS D. LEE, AND ROBERT W. WOOD (1996 WL 1805906 (Bd.Pat.App&Interf.) held that a specification need not have verbatim basis of the terms in the claims. The claimed subject matter need not be described in haec verba to satisfy the description requirement, In re Herschler, 200 USPQ 711 (CCPA 1979).

Further, the Board of Patent Appeals and Interferences in EX PARTE MEL W. ECKLUND, et al. (2000 WL 33149144 (Bd.Pat.App. & Interf.) held that the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, (Fed.Cir. 1991) and In re Kaslow, 216 USPQ1089, (Fed.Cir. 1983).

Applicant's claims easily meet the tests and also provide support for the claimed language.

Even if literal support were not present, Applicant's original claims clearly imply that the invention includes less than 20% resin.

The clear implication is that the recited amount of resin at least is implicitly disclosed for the reasons stated. See Ex Parte Lee and Wood (1996 WL 1805906) (Bd.Pat.App&Interf.), previously cited.

Applicant respectfully traverses the rejection under the second paragraph of 35 U.S.C. 112.

Claim 2 has been amended to provide proper antecedent basis for fibrous base material.

Regarding claims 1 and 10, the Examiner states that a portion of the product is unaccounted for.

Applicant respectfully submits that claims 1 and 10 positively recite what the fibrous base material is. Claim 1 recites 75 to 85 percent fibers; 5 to 25 percent filler; and resin. Claim 10 recites 75 to 85 percent fibers; 10 to 35 percent filler; and resin. To conclude that a portion of the fibrous base material is unaccounted for is not supported by the facts of the instant case.

The Examiner argues that the claims are incomplete because the claimed ranges do not always equate to 100%. Applicant respectfully submits that

nowhere is this the law. Nowhere do patent the laws require that claimed ranges must total 100%. Even if this were the law, one skilled in the art easily could calculate the amount of resin.

The Examiner also states that Applicant fails to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully submits that this conclusion ignores the express limitation recited in the claims. Applicant's claims quite clearly point out and distinctly claim the subject matter of the fibrous base material.

The Examiner states that the fibrous base material is impregnated with a resin, in an unclaimed or unimplied amount. Applicant respectfully submits that the amounts of fiber and filler are expressed in percentages that are so specific that the amount of resin is clear to one skilled in the art.

The Examiner also states that the specification does suggest an amount of resin, with respect to the fibrous base material, of 20% or less.

Applicant, however, respectfully submits that the original claims clearly suggest an amount of resin of 20% or less. Applicant further respectfully submits that the claims as originally presented govern what Applicant regards as his invention, not the specification.

Accordingly, Applicant respectfully asks that the Examiner withdraw the rejection under 35 U.S.C. §112.

Applicant respectfully traverse the rejection of claims 1 – 5, 9 under 35 U.S.C. §103(a) over U.S. Patent No. 5,646,076 to Bortz.

Claims 1 – 5 and 9 patentably distinguish over Bortz in the recitation of 75 to 85% fibers; 5 to 25% filler; and no more than 20% resin.

Nowhere does Bortz disclose or suggest this.

Bortz fails to disclose or suggest what Applicant claims. The mere existence of the key elements Applicant claims is not even found in the reference. As the Examiner admits the reference is silent with respect to the exact amounts of each of the fiber types. The Examiner cannot add to Bortz what is not there.

Without Applicant's specification for a road map, one would not reach the claimed combination. Clearly, the prior art has no appreciation for the high fibrous content Applicant claims. Clearly Bortz is deficient.

The Examiner also asks for a showing of unexpected results with the claimed amounts. Applicant respectfully submits that Bortz is so deficient that such a showing is not required.

The Examiner also states that the proportions appear to be within the ordinarily level of skill of one in the art. Applicant respectfully submits that this conclusion is unsupported in fact or theory. No prior art discloses the high fiber contents Applicant claims. No reference has been cited showing the high fiber contents. One cannot add facts to a reference. No such appearance exists in

Bortz.

Accordingly, Applicant respectfully ask that the Examiner withdraw the rejections under 35 U.S.C. §103.

Applicant respectfully traverse the rejection of claims 7 and 10 – 13 under 35 U.S.C. §103(a) over U.S. Patent No. 5,646,076 to Bortz and further in view of U.S. Patent 5,707,905 to Lam et al.

Claims 10 – 13 patentably distinguish over the references in the recitation of a fibrous base material of 75 to 85 percent fibers; 10 to 35 percent filler; and resin.

The deficiencies of Bortz have been pointed out and will not be repeated herein.

Further, Applicant respectfully submits that the friction materials in Bortz are complete products that have been designed to provide specific performance characteristics and that it is not possible to add or replace components in the material without entirely reengineering the structure of the material. In addition, there is no teaching or suggestion in either of these references that the complete material product that has been designed to achieve specific results can or should be modified.

Still further, Lam et al. do not supply the deficiencies of Bortz. Nowhere does either reference disclose or suggest the high fiber contents Applicant claims.

The cited references do not suggest or teach the combination as claimed by

Applicants. There mere existence of those individual elements is not found in the art. Even if found, they do not lead to the conclusion that the elements should be combined in the manner claimed. No motivation is provided by the art to teach what is claimed. In re Werner Kotzab, 55 USPQ2d 313, 317 – 318 (Fed.Cir. 2000).

Regarding claim 7, Bortz discloses a complete product that needs no modification.

Applicant respectfully submits that one cannot rely on hindsight in reaching an obvious determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. One cannot use hindsight reconstruction to arrive at the claimed invention. See In re Fine, 837 F2d 1071 5 USPQ 1596 (CAFC 1988). The Examiner's rejection ignores the express limitations in the claims. See Bausch & Lomb, Inc. v Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed.Cir. 1986).

Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection under 35 U.S.C. §103.

Applicant respectfully traverse the rejection of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 21 of U.S. Patent No. 6,630,416.

Applicant also respectfully traverses the rejection of the claims under the

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judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/678,720.

Applicant's claims patentably distinguish over the cited art in the recitation of 75 to 85% fibers; 5 to 25% filler; and no more than 20% resin.

As the Examiner points out, the prior art does not teach or suggest a friction material having the high fibrous content. Applicant also respectfully submits that the prior art does not teach a resin content of no more than 20 percent. Clearly the prior art requires at least 25% resin.

Accordingly, Applicant respectfully ask that the Examiner withdraw the double patenting rejections.

Therefore, Applicant respectfully submits that claims 1 – 5, 7, and 9 – 13 as amended are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

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